

## REMARKS

Claims 1-18 are pending in the Application. The Examiner rejected Claims 1-18. No amendments have been made to the claims or specification of the Application.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Examiner rejected Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,311,397 ("Harshberger") in view of U.S. Patent 4,856,295 ("Bolton"). The Examiner states:

2. ... Harshberger et al. disclose a panel mountable electronic device 22 comprising a housing 110, 112, 114, 120 with a heat sink 109 (col. 5, lines 13-17), the housing including a flange 110 with a through hole, a tab 180 rotates of about 90 degrees to clamp a portion of a panel between the tab and the flange, the tab is received in the recess. Harshberger discloses the claimed invention except the threaded hole in the tab and a screw being engaged with the thread hole in the tab. Bolton discloses the screw being engaged with the threaded hole in the tab. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the screw as disclosed by Bolton instead of a locking assembly as disclosed by Harshberger. Harshberger discloses the claimed invention except for materials such as metal or plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Harshberger discloses the claimed invention except specifying the device being an optical transceiver and optical fiber connectors. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the arrangement for an optical transceiver since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

#### **A. References Lack a Suggestion or Motivation to Combine**

The Examiner has not pointed to any suggestion or motivation within the prior art to combine the references of Harshberger and Bolton in the manner described by the Examiner. Applicants respectfully traverse the Examiner's rejection. MPEP § 2143 provides:

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>1</sup> In particular, because neither of the cited references suggests or discloses wherein "a rotation of said screw rotates said tab into position to clamp a portion of said panel," the Examiner's combination of the cited references can only be made by hindsight. Obviousness may not be established by hindsight reconstruction or conjecture.<sup>2</sup>

Additionally, Harshberger actually teaches away from the combination with Bolton. Harshberger includes a combination key operated lock and switch assembly 172. Harshberger states:

Switch assembly 172 is suitable electrically connected to the power supply of unit 142 and logic circuitry to turn the CPU module on and off. ... In this way the computer may be turned off and the key removed from switch 172, but latch 174 remains locked against keeper 178 to prevent inadvertent removal of module 22 from bay module 20." (Column 6, lines 13-28.)

By using the screw of Bolton, the benefits of an easily removable key that operates the electrical circuitry, as highlighted in Bolton, are not realized. Therefore, Harshberger dissuades one from using the disclosure of Bolton. If the Examiner disagrees, Applicant respectfully requests that the Examiner point out the suggestion or motivation to combine the cited references with more specificity in support of this section 103 rejection, as required under MPEP §2143.01 and §2143.03. A *prima facie* case of obviousness not being established, it is respectfully requested that section 103 rejection to be withdrawn.

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<sup>1</sup> In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

<sup>2</sup> ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

**B. References Fail to Disclose the Invention**

Even assuming there existed a motivation to combine Harshberger and Bolton, the combination fails to teach all of the limitations of Claim 1. Neither Harshberger nor Bolton disclose “**wherein said screw may be passed through said hole in said flange and engaged in said threaded hole such that a rotation of said screw rotates said tab into position to clamp** a portion of said panel between said tab and said flange” as recited in Claim 1. Both Harshberger and Bolton only disclose a locking mechanism. Neither discloses a mechanism to “**clamp**” as recited in Claim 1.

Additionally, the rotation of the screw in Bolton does not rotate the tab. The rotation of the screw in Bolton allows only for the tab to be slid from left to right. Specifically, Bolton states “the screw 28 and the attached lock member 23 are slid to the right so as to thereby engage the tab 24 with the flange portion 27, and the screw 28 is then tightened.” (Bolton, column 3, lines 9-12.)

For the above reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1 and 11 and their dependent Claims 2-10 and 12-18, respectively.

**CONCLUSION**

Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 453-9200, extension 1338.

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Respectfully submitted,



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